

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gary L. Sextro et al.
Serial No.: 09/829,468
Filing Date: April 9, 2001
Confirmation No. 8685
Art Unit: 2612
Examiner: Shirley Lu
Title: FEATURES FOR INTERACTIVE TELEVISION

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

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REPLY BRIEF

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer transmitted March 7, 2008. In the Examiner's Answer, the Examiner argues that the final rejections should be sustained. Appellants reply to the arguments in Examiner's Answer.

Argument

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer transmitted March 7, 2008. Appellants filed an Appeal Brief on February 5, 2008 explaining clearly and in detail why the final rejections of Claims 1, 2, 4-18, 24 and 25 are improper and should be reversed by the Board of Patent Appeals and Interferences. Appellants reply to Examiner's Answer ("Answer") and respectfully request that these rejections be overturned and all pending claims be allowed in light of the arguments presented below.

The Examiner rejects Claims 1, 4-10, 12, 13, 15-17, 24 and 25 under 35 U.S.C. 103(a) as being clearly unpatentable over U.S. Publication No. 2004/0117831 to Ellis et al ("Ellis") in view of U. S. Patent No. 5,938,737 to Smallcomb ("Smallcomb"). The Examiner rejects Claims 2 and 14 under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of *Smallcomb*, and in view of U.S. Publication No. 2002/0007493 to Butler et al ("Butler"). The Examiner rejects Claim 18 under 35 U.S.C. 103(a) as being unpatentable over *Butler* in view of *Smallcomb*, and in view of *Ellis*. The Examiner rejects Claim 11 under 35 U.S.C. 103(a) as being unpatentable over *Butler* in view of *Ellis*.

Appellants argue in their Appeal Brief, that Examiner has failed to carry his burden of establishing that the *Ellis-Smallcomb* combination teaches each element of Claim 1. In particular, the Examiner has failed to show that the *Ellis Provisional* properly supports the subject matter relied upon to make the rejection. Specifically, the *Ellis Provisional* does not provide support for Appellants' limitation reciting "providing a digital interactive set-top box coupled to a standard television, said interactive set-top box **accessing said additional internet-based content and superimposing said content on said video stream.**"

In their Appeal Brief, Appellants pointed out that Examiner has failed to particularly identify the portions of the *Ellis Provisional* relied on to support the rejection of this element of Claim 1. Now, for the first time during the prosecution of this Application, Examiner finally discloses the portion of the *Ellis Provisional* contended to disclose the set-top box of Claim 1. The portion relied on is not even included in the text of the provisional, but rather is an application that is incorporated by reference. (Answer p. 15). In addition to violating 37 C.F.R. § 1.104(c)(2), the Examiner's failure to disclose the portion of the *Ellis Provisional*

relied on prior to submitting the Answer shows that Examiner's argument has no merit. If such incorporation by reference actually taught the elements of Appellants' Claim 1, the Examiner would have cited it before now. This desperation argument is not even supported by the reference as contended. For example, the Answer states that "the *Ellis Provisional* incorporates in its entirety, Application 09/229047 [U.S. Patent No. 6,536,041 issued to Knudson ('Knudson'), which discloses a set-top box on page 3." (Answer p. 15). While *Knudson* may disclose a set-top box, it does not disclose, teach, or suggest the set-top box of Appellants' Claim 1. Rather, *Knudson* discloses a set-top box 52 that may have data such as a program guide periodically distributed to it and stored in database 53. (*Knudson*, col. 7, lines 9-10). There is no disclosure in *Knudson* that the set-top box **accesses additional internet-based content and superimposes this content on a video stream as recited by Claim 1**. Notably, the Examiner fails to even assert that *Knudson* discloses this limitation; she cannot.

Also as a first time argument, the Examiner contends that the above-referenced element is not supported by Appellants' Provisional Application filed April 8, 2000 (Appellants' Provisional). Examiner makes another desperation argument that, if it had any merit, would have been made earlier in the prosecution of the Application as opposed to as a last ditch effort in the Answer. Appellants' Provisional supports each of the elements of Claim 1 under the first paragraph of 35 U.S.C. § 112. MPEP § 2163.03(III). For example, Appellants' Provisional states that "while it is clear that some sort of internet protocol will most likely be used to implement the interactivity portion, it is also desirable to provide for simultaneous broadcast through traditional and interactive receivers. At least this statement would inform those skilled in the art how to make and use the element of Claim 1 which recites providing a digital interactive set-top box coupled to a standard television. Apparently, the Examiner has improperly focused on the fact that the phrase "set-top box" is not used in Appellants' Provisional, but the exact words of the claims need not be present in the specification to provide an adequate disclosure under 35 U.S.C. § 112. MPEP § 2163(II)(A)(3)(a). Appellants' Provisional further discloses that, "[o]ne method of enabling a smooth transition is to use traditional broadcasts, with imbedded HTML or Java-like commands to access the interactive features of advanced televisions. These imbedded commands can enable synchronization and correlation to additional internet based content that is displayed with the broadcast signals." (Appellants' Provisional p. 1). One of ordinary skill in the art would understand at least these statements as enabling one of ordinary skill in

the art to make and use the element of Claim 1 reciting accessing additional internet-based content and superimposing that content on a video stream without undue experimentation. Accordingly, Claim 1 is fully supported by Appellants' Provisional Application, and thus Examiner must rely on the *Ellis Provisional* to support the portions of *Ellis* he claims discloses the elements of Claim 1. MPEP § 706.02(VI)(D).

For at least these reasons and those set forth in the Appeal Brief, independent Claim 1 is allowable, as are Claims 2, 4-5, 8-10, 12-16, and 24-25 that depend therefrom. For analogous reasons, independent Claims 11 and 18 are allowable. Reconsideration and favorable action as to the rejection of these claims are requested.

Claim 6 is allowable at least because the combination of *Ellis* and *Smallcomb* does not disclose, teach, or suggest "storing one or more of said video clips of said selected plays; [and] summarizing said stored video clips with a graphic summary including coded indicators denoting types of plays." The Answer contends that page 7 of the *Ellis Provisional* discloses a sports fan hub, which is a VOD of recorded sporting events. (Answer p. 16). However, there is nothing in the cited section of the *Ellis Provisional* that discusses a sports fan hub that discloses storing one or more said video clips of selected plays, or summarizing said stored video clips with a graphic summary including coded indicators denoting types of plays. The Examiner's Answer, for the first time during the prosecution of this Application, cites the sports browser of *Knudson* as a portion of the *Ellis Provisional* (incorporated by reference) that teaches these elements of Claim 6. The portion of *Knudson* cited by the Examiner does not disclose, teach, or suggest the elements of Claim 6 as contended. While *Knudson* may disclose a sports menu 112, sports menu 112 is merely a menu of a program guide, it does not store one or more video clips of selected plays, and summarize these stored video clips with a graphic summary including coded indicators denoting types of plays as recited by Claim 6.

For at least these reasons, Appellants contend that the combination of *Ellis* and *Smallcomb* does not disclose, teach, or suggest each of the elements of Claim 6. Appellants' respectfully request that the rejection of Claim 6 be overturned. For analogous reasons, dependent Claim 24 is also allowable. Reconsideration and favorable action are requested.

Independent Claim 17 is allowable at least because the combination of *Ellis* and *Smallcomb* does not disclose, teach, or suggest providing task bars displaying various accounts in the home. The Examiner's Answer contends that this element is supported by the *Ellis Provisional* at page 9, where it discloses "personal profiles for various members," and page 13, where it discloses individual users within the household may define their own hubs . . ." (Answer p. 16). While the Examiner may have accurately quoted the *Ellis Provisional*, such portions of the *Ellis Provisional* do not disclose, teach, or suggest providing task bars displaying various accounts in the home. As a result, the combination of *Ellis* and *Smallcomb* fails to disclose, teach, or suggest providing task bars displaying various accounts in the home. For at least this reason, Independent Claim 17 is allowable. For analogous reasons, Dependent Claim 25 is also allowable. Reconsideration and favorable action are requested.

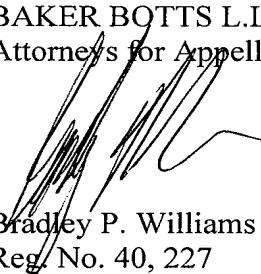
Conclusion

Appellants have demonstrated, through their Appeal Brief and this Reply Brief, that the present invention, as claimed, is clearly distinguishable over the references cited by the Examiner. Therefore, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the Examiner's final rejection of the pending claims and instruct the Examiner to issue a notice of allowance of all pending claims.

Appellants believe no fees are due in the filing of this Reply Brief. However, the Commissioner is hereby authorized to charge any fee and credit any overpayment to **Deposit Account No. 20-0668 of Texas Instruments.**

Respectfully submitted,

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